

REMARKS

The claims have been amended as suggested by the Examiner to more particularly point out and distinctly claim the invention. Applicants submit herewith a statement by Attorneys for Applicants regarding the permanence and availability of the plasmid and cell line deposits.

1. The Examiner's Rejection for Double Patenting

Claims 37-41, 49-51 and 62-64 are provisionally rejected under the judicially created doctrine of double patenting over Claims 37-44, 46-50, 52 and 56-57 of copending application Serial No. 08/333,680 (the '680 application). The '680 application has been suspended since January 25, 1999 in view of a potential interference. The Applicants are prepared to file a terminal disclaimer in the '680 application.

2. The Rejections Under 35 U.S.C. § 112 First Paragraph, Should Be Withdrawn

Claims 42 and 51 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains. The Examiner contends that the Declaration submitted by the Applicants on December 10, 1998 referred to microorganisms instead of plasmids on page 2, paragraphs 1 and 2, and that the Declaration did not indicate all of the restrictions on the availability of the 293 cell line containing the adenovirus 5 E4 ORF6 DNA fragment. As requested by the Examiner, Applicants submit herewith a new Deposit Declaration referring to the plasmids deposited, and specifying that all restrictions on availability of the deposited materials will be irrevocably removed upon granting of a patent. The submission of this Declaration obviates the Examiner's rejection, therefore the rejections under 35 U.S.C. §112, first paragraph should be withdrawn.

3. The Rejections Under 35 U.S.C. § 112 Second Paragraph, Should Be Withdrawn

Claims 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the present invention. The Examiner contends that Claim 62 recites improper Markush claim language in that the members of the Markush group need to be linked by "and". In response

to the Examiner's rejection, Claim 62 has been amended as suggested by the Examiner to more distinctly claim the invention, thus obviating the Examiner's rejections of these claims.

In view of the foregoing amendments and remarks, Applicants submit that the rejections under 35 U.S.C. §112, second paragraph should be withdrawn.

CONCLUSION

Applicants respectfully request entry and consideration of the foregoing amendments and remarks. Applicants believe the claims to be in condition for allowance.

Respectfully submitted,

by: Jacqueline Benn
Reg No. 43,492

Date June 21, 1999

Laura A. Coruzzi 30,742
Laura A. Coruzzi (Reg. No.)
PENNIE & EDMONDS LLP
1155 Avenue of the Americas
New York, New York 10036-2711
(212) 790-9090

Enclosure

BEST AVAILABLE COPY